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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,177	07/31/2003	Renee M. Kovales	RSW920000128US2	9830

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IBM CORPORATION
3039 CORNWALLIS RD.
DEPT. T81 / B503, PO BOX 12195
REASEARCH TRIANGLE PARK, NC 27709

EXAMINER	
PATEL, HEMANT SHANTILAL	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,177	KOVALES ET AL.	
	Examiner	Art Unit	
	Hemant Patel	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,9,11,14,15,17,18,20-24,28,34,37,90 and 96-98* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34,37 and 96-98* is/are rejected.

7)☒ Claim(s) *1,9,11,14,15,17,18,20-24,28 and 90* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Applicant Response dated June 27, 2006 to an Office Action dated March 29, 2006 is entered. Claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 34, 37, 90, 96-98 are pending in this application.

Response to Amendment

2. Applicant's arguments with respect to claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 34, 37, 90, 96-98 have been considered but are moot in view of the new ground(s) of rejection. The rejections are necessitated due to claim amendments and addition of new claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 recites "the voice mail message" (ll. 3-4, 13). It is not clear if it refers to "a voice mail message" on ll. 1 or "voice mail message" on ll. 3. It also recites "the listener" (ll. 13). It is not clear if it refers to "a listener" on ll. 2 or "a listener" on ll. 3. Further, it recites "at least two of the message segments which are to have background sound associated therewith" (ll. 5-6). This suggests that each segment has the same background sound.

But in contradiction to this, the claim (ll. 7-9) recites to associate different sounds to different message segments.

5. Claims 96-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 96 recites "upon initiating a telephone call from the telephone device, blending at least one of the prerecorded sound files with a voice message of the initiated telephone call". It is not clear if this blending is performed as soon as voicemail greeting is played by the called party's answering device or voicemail system, or when the caller starts leaving a voicemail message for the called party. Further, the word "upon" means "on" and "on" means "used to indicate occurrence at a given time" (The American Heritage College Dictionary, fourth edition, 2004, ISBN 0-618-45300-8, pg. 1506 for "upon", pg. 971 for "on"). Thus, it suggests blending sound file with voice message when phone call initiation starts. This is not possible since voice message does not occur when phone call initiation starts. The phone call goes through steps of dialing and terminating before voice message can start.

Also, Independent claim 26 recites "statically configuring a telephone device". It is not clear how static is configuration. It is not clear if the manufacturer statically configures it and the user cannot modify the configuration or the user statically configures it by adding pre-recorded sound files.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 34, 37 are rejected under 35 U.S.C. 102(a) as being anticipated by Roth (US Patent No. 6,975,988 B1).

Regarding claim 34, Roth teaches of a caller creating a voice mail message using telephone (Fig. 3, step 2112; col. 6, ll. 45; col. 10, ll. 40-43; col. 12, ll. 18-20; multi-mail with spoken message) and the message comprises plurality of message segments (audio, image, animation); caller using the telephone device selects an audio file to insert in the message (Fig. 11, step 1112.1; col. 8, ll. 45-col. 9, ll. 3; col. 9, ll. 60-61; col. 10, ll. 3-4); and synthesizing this multi-mail voice message to playback with the effect of associated sound, image and animation (col. 10, ll. 7-24; Fig. 3, step 2111; col. 6, ll. 43-44).

Regarding claim 37, Roth teaches of an audio file as caller's own speech in different forms (col. 8, ll. 49-54).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 96-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yi (US Patent No. 6,407,325 B2).

Regarding claim 96, Yi teaches of statically configuring a telephone device with a plurality of pre-recorded sound files (Fig. 1, item 211; col. 2, ll. 43-52; col. 3, ll. 21-22, MMC); inserting the sound files (i.e. background music) in conversation between caller and called party (col. 2, ll. 13-15; col. 4, ll. 35-39, 58-59; col. 5, ll. 55-60). In other words, Yi teaches of blending sound files with a 2-way conversation but is not explicit on teaching of blending the files in a 1-way conversation i.e. mixing the sound files when only one party is speaking. However, it would be very obvious if not inherent that the sound files are blending with the conversation even when only one party speaks. Regarding the claimed "voice message", Yi teaches of a conversation (col. 5, ll. 50-55)

which is inherently having a voice message, because at least one party is voicing a message to converse.

Regarding claim 97, Yi teaches that the caller selects the background music (col. 2, ll. 51-52).

Regarding claim 98, Yi teaches that the background music is pre-recorded sound files (col. 3, ll. 21-22, storing MP3 data; col. 5, ll. 30-32, downloaded music files).

Allowable Subject Matter

11. Claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 90 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

12. The following is a statement of reasons for the indication of allowable subject matter:

Claim 1, Roth teaches of creating voice mail message with plurality of message segments using a telephone, applying a background sound and playing the synthesized message to a listener with the effect of background sound.

Roth does not teach of caller identifying, selecting and associating more than one background sound files to multiple segments of the voice mail message using the telephone device.

The other prior art of record fails to teach or suggest substantially modifying Roth with this specific feature in order to arrive at the invention as claimed in detail by the applicant.

Claims 9, 11, 14-15, 17-18, 20-24, 28, 90, they are dependent on allowable claim 1.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,434,910 Johnson

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel
Examiner
Art Unit 2614

HSP

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600